

Remarks

U.S. Patent No. 5,788,639 (Zavislan et al.) is disqualified as prior art under 35 U.S.C.103(c) effective November 29, 1999 for applications, including continuations and divisionals, filed on or after this date (see MPEP 706.02(l)(l)). The present U.S. Patent Application No. 09/658,736 and the Zavislan et al. patent were, at the time U.S. Patent Application No. 09/658,736 was made owned by Lucid, Inc. The Zavislan et al. patent which qualifies as prior art under 35 U.S.C. 102(e) is thus disqualified as prior art for purposes of an obvious type rejection under 35 U.S.C. 103(c). Note that the Zavislan et al. patent would not be prior art under 35 U.S.C. 102(a) since its patented date August 4, 1998 is not before the invention of U.S. Application No. 09/658,736 as evident by the priority of U.S. Application No. 09/658,736 to U.S. Provisional Application 60/108,847 filed October 18, 1996, or U.S. Patent Application No. 08/942,431, filed October 1, 1997. Since the Zavislan et al. patent relied upon by the Examiner in the obviousness rejections is now disqualified prior art to the present Application, Applicant requests withdrawal of the obviousness-type double patenting rejection, and 35 U.S.C. 103(a) rejections with respect to Claims 1-3, 6, 8, 19, 26-36, and 42-48.

Claims 1, 19, 26-34, and 42-46 were rejected as being anticipated by Zavislan et al. Claims 1, 26, and 43, as amended, describe means for maintaining an area of tissue under stress by application of force against a plate, in which the maintaining means comprises a member extending from the plate and at least part of the member lies against the tissue. Figures 1 and 3 of Zavislan et al. have no such member with respect to tissue. Thus, Claims 1, 26, and 43, and their respective dependent Claims 19, 27-34, 42, and 44-46 are not anticipated by Zavislan et al., and withdrawal of the anticipation rejection is requested.

Claims 49 and 50 were rejected as being anticipated by U.S. Patent No. 5,146,923 (Dhawan). This rejection is respectfully traversed since Dhawan cannot produce one or more images of optically formed sections within the stressed tissue, as described in Claim 49. Dhawan describes a nevoscope which uses a still or video camera (9) of Fig. 1 or camera 74 of Fig. 5 to record images of tissue (see column 7, lines 8-10). A still or video camera cannot provide an image of a section through tissue, but rather provides an image of the tissue surface, or an image of a volume of tissue transilluminated from the surface

to a depth. The camera (9 and 74) of Dhawan captures an image of the tissue but cannot optically discriminate any section under the surface. Dhawan cannot optically form a sectional image. Accordingly, Dhawan relies on computer tomography to obtain sections (see top paragraph of column 3, and a computer-reconstructed cross-section of tissue at column 5, and especially, column 5, at lines 11-16 and 53-57). Computer-reconstructed sections are not optically formed, as called for in Claim 49. Clearly, if Dhawan was capable of providing images of optically formed sections, why would it describe use of computer reconstruction to generate an image of a cross-section? Therefore, Dhawan does not anticipate Claim 49 and its dependent Claim 50.

Claim 20 has been cancelled without prejudice in favor of new Claim 52 which clarifies the apparatus having a platen with an orifice. Claim 52 is believe patentable over the references previously cited against Claim 20 since none of these references disclose the claimed carriage. Claims 51 now depends on Claim 52. New Claim 53 depends on Claim 52 and describes that the platen supports the imaging head, and that the imaging head is positionable with respect to the orifice of the platen.

Claims 21 and 22 were held allowable but objected to as being dependent on rejected claims. Claim 21 has been rewritten with Claim 20 as set forth prior to the last Amendment. Claim 22 depends on allowable Claim 21.

A Sixth Supplemental Information Disclosure Statement is enclosed.

It is believed that this application is in condition for allowance, and a Notice of Allowance is respectfully solicited. A check for \$25.00 is enclosed for new Claims 52-53.

Respectfully submitted,



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Enclosures: Sixth Supplemental Information Disclosure Statement with 1 PTO-1449
Form listing 3 references (attached); and
Amendment Transmittal Letter with check for \$25.00.